

### REMARKS

Claims 11-20, 22-28, and 30-44 are withdrawn from consideration. By this amendment, claims 1-10 and 29 are cancelled without prejudice or disclaimer, claim 21 is amended, and new claims 45-56 have been added. Claims 21 and 45-56 are pending in this application.

Support for amended claim 21 can be found, at least, at page 16 lines 10-29, page 35 line 21 to page 36 line 1, page 49 lines 1-3, and page 66 line 6 to page 67 line 5.

Support for new claims 45-55 may be found, for example, on page 17 lines 10-17, and page 37 line 1 to page 38 line 30.

Support for new claim 56 may be found on page 35 lines 10-19 and page 61 lines 29-30

### Objections to the Specification

The Examiner has objected to the abstract of the disclosure. Applicants note that a Preliminary Amendment dated October 13, 2000 (a copy of which is enclosed herewith for the Examiner's convenience) was submitted providing an abstract on a separate sheet numbered page 77.

The Examiner has objected to the title. Applicants have amended the title to read: "Seed-Coat Promoter."

### Claim Objections

Claim 21 is objected to under 37 CFR 1.821(d) for not making reference to DNA by use of a sequence identifier. Applicants have amended claim 21 to make reference to SEQ ID NO: 8.

35 U.S.C. §112 Rejections

The Examiner has rejected claims 1-10 and 29 under 35 U.S.C. §112, first paragraph for failure to comply with the written description requirement. Without acquiescing to Examiner's rejection, and for reasons completely unrelated to patentability, Applicants have cancelled claims 1-10 and 29 without prejudice and disclaimer, and reserve the right to pursue this subject matter in a divisional application. As claims 1-10 and 29 have been cancelled, withdrawal of Examiner's rejection is respectfully requested.

Claims 1-10 and 29 have been rejected under 35 U.S.C. 12, second paragraph, with regards to the phrase "differentially expressed." As indicated above, claims 1-10 and 29 are cancelled without prejudice or disclaimer for reasons completely unrelated to patentability, and therefore withdrawal of Examiner's rejection is respectfully requested.

The Examiner has rejected claim 21 under 35 U.S.C. §112, second paragraph, for characterizing the recited isolated genomic DNA according to the restriction map of Figure 11(a). Applicant has amended claim 21 to remove reference to the restriction map of Figure 11(a) and to include a reference to SEQ ID NO: 8. Accordingly, withdrawal of Examiner's rejection is respectfully requested.

Claim Rejections Under 35 U.S.C. §101 and 35 U.S.C. §112

The Examiner has rejected claims 1-10, 21 and 29 under 35 U.S.C. 101, alleging that the claimed invention is not supported by either a specific and substantial asserted utility or a well-established utility (see page 6 of Action). Applicants respectfully traverse Examiner's rejection, submitting that the differential expression of a gene of interest under control of the claimed isolated genomic DNA sequence of the invention localized within seed-coat tissues demonstrates a specific and substantial utility. The use of the isolated sequence of the present invention allows seed specific expression of heterologous coating sequences that are incorporated under the control of the genomic DNA as stated, for example, on page 35 lines 10-19. Practical examples of such differential expression are described at pages 37 and 38 of the specification.

The Examiner has further rejected claims 1-10, 21 and 29 under 35 U.S.C. 112, first paragraph, again alleging that a specific or substantial utility has not been demonstrated. As indicated in the previous paragraph, Applicants submit that utility lies, at least, in providing differential expression of a heterologous gene under the control of the isolated genomic DNA of the present invention. Furthermore, as indicated above, claims 1-10 and 29 are cancelled without prejudice or disclaimer for reasons completely unrelated to patentability. Accordingly, withdrawal of Examiner's rejections under 35 U.S.C. §101 and 35 U.S.C. §112 is respectfully requested.

#### 35 U.S.C. 102 Rejections

The Examiner has rejected claims 1-10 and 29 under 35 U.S.C. 102(b). As indicated above, claims 1-10 and 29 have been cancelled for reasons completely unrelated to patentability, and therefore Examiner's objections with regards to these claims are moot. Accordingly, withdrawal of Examiner's rejection is respectfully requested.

CONCLUSION

It is respectfully submitted that the above-identified application is now in condition for allowance and favorable reconsideration and prompt allowance of these claims are respectfully requested. Should the Examiner believe that anything further is desirable in order to place the application in better condition for allowance, the Examiner is invited to contact Applicants' undersigned attorney at the telephone number listed below.

Respectfully submitted,



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